

Remarks

Claims 1-22 were presented for prosecution and remain pending. By this Amendment, the specification has been amended. The above amendment and the following remarks are being made to facilitate early allowance of the presently claimed subject matter. Applicants do not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicants reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the above amendments and following remarks is respectfully requested.

Entry of this Amendment is proper under 37 C.F.R. §1.116(b) because the Amendment: (a) places the application in condition for allowance as discussed below; (b) does not raise any new issues requiring further search and/or consideration; and (c) places the application in better form for appeal. Accordingly, Applicants respectfully request entry of this Amendment.

In the Office Action, the Office kindly reminds that the specification of the claimed invention does not specifically recites "non-MICR format." By this Amendment, the specification has been revised accordingly. Applicants submit that the original disclosure provides antecedent basis for this amendment and no new matter has been added.

In the Office Action, claims 1, 2, 8, 9, 11, 15, 16 and 17 were rejected under 35 USC 103(a) as allegedly being unpatentable over Simonoff (US Patent 6,195,453) in view of Kruppa (US Patent 6,243,504). Claim 21 was rejected under 35 USC 103(a) as allegedly being unpatentable over Kruppa in view of Simonoff. Claims 3, 4, 6, 7, 10, 13, 14, 19, 20

BEST AVAILABLE COPY

10/081,417

7

and 22 were rejected under 35 USC 103(a) as allegedly being unpatentable over Simonoff and Kruppa in further view of Higgins et al. (US Patent 5,091,968). Claims 12 and 18 were rejected under 35 USC 103(a) as allegedly being unpatentable over Simonoff and Kruppa in further view of Tateishi (US Publication 2003/0059099). Applicants respectfully traverse these rejections for the reasons stated below.

Applicants respectfully submit that the prior art fails to teach or suggest all of the claim limitations. For instance, the claimed invention include, *inter alia*, "a conversion system for converting the character data to a Magnetic Ink Character Recognition (MICR) format from a non-MICR format[.]" as recited in claim 1 and claimed similarly in claims 8, 15 and 21. The Office alleges that Simonoff teaches such a conversion system. Applicants respectfully traverse this assertion because Simonoff does not disclose or suggest a MICR format character data. Please note, in the claimed invention, a MICR format character data "has the equivalent specifications of data obtained by a multigap MICR read head." (See specification of the claimed invention at page 6, lines 9-10; see also claim 15.) Please also note, a MICR code as printed in a check is not equivalent to a MICR format character data as obtained by a multigap MICR read head. In Simonoff, the scanned MICR codes are first identified using an OCR process (see e.g., claim 1). Once they are identified, they are validated (claim 3) and then regenerated, i.e., printed using stored MICR fonts (claim 1). As such, Simonoff does not disclose or suggest a MICR format character data. The "stored MICR fonts" in Simonoff are not MICR format character data because the stored MICR fonts do not have the equivalent specifications of data obtained by a multigap MICR read head. Please note, a format of data obtained by a MICR read head is distinct to the format of the MICR fonts to be printed by a printer. As other evidence to show the difference between the

MICR fonts of Simonoff and the MICR format character data of the claimed invention, according to the claimed invention, and as is well known in the art, a MICR format character data cannot be directly recognized by a printer to print out MICR codes, but needs to be recognized by a MICR recognition engine. (See specification of the claimed invention at page 6, lines 11-17.) In contrast, the MICR fonts of Simonoff are directly recognized by a printer to print out the MICR codes. As such, the MICR fonts of Simonoff are not MICR format character data. In the Office Action, the Office interprets "printed MICR font character" as "MICR format." (See Office Action at page 3.) Applicants respectfully submit that such an obviously over-broad interpretation of MICR format character data is not warranted, as discussed above, and "MICR format character data" as used in the claimed invention does not include a "printed MICR font character."

In addition, Applicants submit there is no motivation or suggestion to combine the references as suggested. In the Office Action, the Office asserts that there is motivation to combine because Simonoff prints a negotiable document to be deposited at banks which needs to be recognized by "a recognition engine as taught by Kruppa." (See Office Action at page 3.) Applicants respectfully submit that such a "motivation to combine" cannot render the claimed invention obvious because Simonoff and Kruppa are not combined in a manner to reach and suggest all features of the claimed invention. For example, Simonoff lacks "a recognition engine for interpreting the converted (MICR format) character data." (Claim 1 of the claimed invention). (Parenthetical explanation added). In the Office Action, however, Kruff is not used to overcome this deficiency of Simonoff. As the Office admits, the combination is made to recognize printed negotiable documents with a MICR code, not to interpret the converted MICR format character data. Please note, a recognition of a

BEST AVAILABLE COPY

negotiable document with MICR codes, per se, does not render the claimed invention obvious because the claimed invention provides a specific approach, including the claimed limitations, to this objective, which the cited prior art fails to disclose or suggest. In view of the foregoing, the Office fails to establish a *prima facie* case of obviousness and Applicants respectfully request withdrawal of the rejections.

The dependent claims are believed allowable for the same reasons stated above, as well as for their own additional features.

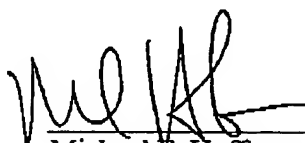
Conclusion

Applicants respectfully submit that the application is in condition for allowance. If the Examiner believes that anything further is necessary to place the application in condition for allowance, the Examiner is requested to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

Dated:

11/2/05



Michael F. Hoffman
Reg. No. 40,019

Hoffman, Warnick & D'Alessandro LLC
75 State Street, 14th Floor
Albany, New York 12207
(518) 449-0044
(518) 449-0047 (fax)

BEST AVAILABLE COPY